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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,477	11/30/2001	John Curtsinger	0275Y-000536	6540

27572 7590 12/10/2003

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EXAMINER

ALIE, GHASSEM

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,477

Applicant(s)

CURTSSINGER, JOHN

Examiner

Ghassem Alie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/05/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Election/Restrictions

1. Applicant's election of Group VI (Claims 59-63) in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 59 and 61-63 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 40, 42, 43, and 54 of copending Application No. 10/122,156. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Regarding claim 59, "a saw blade" and "at least one saw blade" define the same limitation and have an overlapping meaning. The terms "the first portion of the cover disposed against the first side of the saw blade" and "the first portion of the cover facing the first side of the wall" also define the same limitation and have an overlapping meaning.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*,

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759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 59-65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40, 42, 43, and 54 of copending Application No. 10/122,156. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 59, and 61-63 are anticipated by the claims in application No. 10/22,156. Regarding claim 59, "the first portion of the cover facing the first side of the saw blade" and a "the first portion being disposed against the first side of the at least one saw blade" have an overlapping meaning that at least define the same limitation. The first portion of the cover inherently is facing the first side of the blade by being disposed against the first side of the saw blade.

Regarding claim 60, the first portion inherently has a generally circular peripheral edge since the first and second portions form a ring channel as set forth in claim 43 of application No. 10/122,156. The second portion also extends from the first portion since the first and second portions are connected together in a shape of a ring.

Regarding claims 64 and 65, the first portion of the cover is disposed against the first portion of the saw blade and the second portion of the cover is inherently disposed against the second side of the saw blade. The second portion of the cover is folded over the first portion and the saw blade and the saw blade is secured within the channel between the first

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and second portions of the cover as set forth in claim 43 of application No. 10/122,156.

Therefore, the first and second portions of the cover are disposed against the first and second sides of the saw blade.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negative by the manner in which the invention was made.

7. Claims 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (2,010,082) in view of Curry (2,878,628). Hill teaches a saw blade S including first and second sides, a peripheral edge, and a plurality of teeth that extend along the peripheral edge. The saw blade S has a first side and second sides that are covered by the disks D and D' and a peripheral edge that is shown in Hill's Fig. 2. Hill also teaches a cover C, C' that has first and second portions with opposite inner and outer surfaces. Hill also teaches that the first portion of the cover C, C, is facing the first side of the saw blade S and the second portion of the cover C, C' is folded over the first portion with the inner surface of the second portion facing the second side of the saw blade S. The cover C, C, has a first and second portions which are extending from its peripheral edge. The first and second portions each have inner surface, which is covered by gum type material. The inner surfaces of the cover's portions are also facing disks D, and D' and the both sides of the blade S. Hill also teaches that the teeth of the saw S blade are secured between the first and second portions of the cover. See Figs. 1-2 and page 1, lines 1-55 in Hill. Hill does not teach that the cover is made of a heat

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shrinking material. However, Hill teaches that the cover C, C' covers the teeth of the saw blade S and the disks D and D'. The cover C, C' is considered to be made of a heat shrinking material since it has an application of a hard gum type material that can be melted in response to heating for cementing the cover C, C' to the surfaces of the disks D, D'. In addition, the use of the heat shrinking material for wrapping an article with delicate surface is well known in the art as taught by Curry. Curry teaches a cover 8 made of heat shrinking material that covers a threaded surface 4. See Figs. 6 and 7 and col. 1, lines 57-72 and col. 2, lines 1-69 in Curry. It would have been obvious to a person of ordinary skill in the art to provide Hill's protective cover with the heat shrinking material as taught by Curry in order to adhere the cover to the sides of the disks in response to heating as hinted by Hill.

Regarding claim 60, Hill teaches everything noted above including that the saw blade S is generally circular and the first portion has a generally circular edge and the second portion extends from the first portion along peripheral edge of the first portion. The cover C, C' forms a circular ring around the peripheral edge of the circular blade S. The first portion of the cover C, C' has a round peripheral edge and the second portion of the cover C, C' extends from the peripheral edge of the first portion. The cover C, C' has first and second portions that are attached to the disks D, D'. See Figs. 1 and 2 in Hill.

Regarding claims 61 and 62, Hill teaches everything noted above including that the first portion of the cover C, C' has a circular central opening and forms a ring shape with the second portion of the cover C, C'. The ring shape has an annular channel between the inner surface of the first and second portions in which the portions of the first and second sides and the teeth of the saw blade S reside. The portions of the cover C, C' form a channel that the

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portion of the both sides of the blade, the teeth of the blade, and the disks D, D' reside as shown in Fig. 1 in Hill.

Regarding claim 63, Hill as modified by Curry teaches everything noted above but Hill as modified by Curry dose not expressly teaches that the heat shrinking material is PVC. However, Hills teaches that the wrapping material 8 may be rubber hydrochloride or other material having similar characteristics. The polyvinyl chloride (PVC) material inherently has a similar heat shrinking characteristics as the hydrochloride material. See col. 1, lines 65-70 and col. 2, lines 1-30 in Curry.

Regarding claim 64 and 65, Hill teaches everything noted above except that the first and second portions of the cover are respectively disposed against the first and second sides of the blade. However, Curry teaches that the cover 8 has first and second portions that are disposed against the first and second sides of the blade 2. The wrapping material 8 has portions that extend from the peripheral surface of the balled threaded 2. The portions of the wrapping material 8 are disposed against the sides of the balled threaded 2. See Figs. 6 and 7 in Curry. It would have been obvious to a person of ordinary skill in the art to provide Hill's protective cover with the heat shrinking material as taught by Curry in order to adhere the cover to the sides of the blade in response to heating and eliminate the use of the disks which are located between the first and second portions of the cover and the blade.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson (2,954,118), Kephart, JR (3,326,250), Poust (2,598,192), Wohlforth (3,018,883),

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Schurman (4,369,575), Paulick (2,918,165) and teach a protective cover for a saw blade.

Ali (6,029,815), Anderson et al. (3,274,302), Gowen (5,145,283), Mueller (4,566,923),

Boucher et al. (5,819,931), and Mushinski (5,114,012), teach a heat shrinking material covering a article.

Nealy (5,211,322) and Bannon et al. (5,456,057) teach a heat shrinking material made of PVC.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (703) 305-4981.

The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (703) 305-1082. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

GA/ga

December 02, 2003


Allan N. Shoap
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